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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,806	08/18/2003	Bill J. Pope	05261.058/6069.2 P	4773

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EXAMINER

FOOTLAND, LENARD A

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/643,806	POPE ET AL.	
	Examiner	Art Unit	
	Lenard A. Footland	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-3,5-18,20,21,25-27,29 and 39-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,19,22-24,28 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3-22-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election without traverse of the combination invention and the species of species of Fig(s). 2a-1 and 2a-2 is acknowledged. Claim(s) 1-3, 5-18, 20-21, 25-27, 29, and 39-57 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to non-elected species, not all claims depending upon or otherwise including the limitations of an allowed generic claim. It should be noted that these claims include claims 10 and 17-18, held nonelected because they depend on nonelected species claims. Also, on 8-10-06, noting that the examiner had in his requirement not listed a number of claims as subcombination claims that he should have, the examiner phoned the attorney to see if he wanted to reconsider his combination election, but the attorney indicated he would continue with it despite the additional claims that would be withdrawn.

Applicant is reminded that if the amendment of any claims results in a change of the species they read upon, that is required to be indicated. Failure to do so will be construed as an indication that the readability has not changed. In addition, if any new claims are added, it is required that the applicant indicate which of them read on the elected species. Failure to do so will result in a holding of nonresponsiveness.

Claim(s) 32, 33-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner finds that they are unclear and confusing, for instance with regard to the elected species, for the following exemplary reasons.

Claim 22's continuous phase polycrystalline diamond. The features of claims 32, 33, 34-38.

These features do not refer to the elected species. This rejection is made to provide applicant the opportunity to appeal this determination of nonreadability.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim(s) 4, 19, 23-24, 28, 30, 31 (and claims 32, 33, 34-38 to the extent reading on the elected species) are rejected under 35 U.S.C. § 102(e), as being anticipated by Fridez et al. ("Fridez") or Hall et al. ("Hall")

Fridez discloses all of the claimed elements including, for example, the diamond coating near 3 and substrate near 2. All rolling bearings slide to a degree.

Art Unit: 3682

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (571) 272-7103.

Fax: 703-872-9326

A handwritten signature in cursive script, reading "Lenard A. Footland". The signature is written in black ink and is positioned above the printed name.

Lenard A. Footland

Primary Examiner

Technology Center 3600

Art Unit 3682

laf

August 16, 2006